

I hereby certify that this correspondence, totaling 20 pages including recited attachments, is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 C.F.R. §1.8 on the below date:

Signature: /Nilay Dabiv

Applicant's Attorney believes that the patent term adjustment should be 874 days. For the reasons stated herein, reconsideration of this patent term adjustment is respectfully requested pursuant to 37 C.F.R. 1.705(d). Please charge the petition fee pursuant to 37 C.F.R. § 1.118(e) to

Deposit Account No. 23-1925. Please charge any additional fee required or credit for any excess fee paid to Deposit Account No. 23-1925. A duplicate copy of this Petition is attached.

The patent term adjustment for U.S. Patent No. 7,520,881 was calculated by the U.S. Patent and Trademark Office based on activities and associated dates detailed in the Patent Application Information Retrieval (PAIR) system Patent Term Adjustment History, attached as Exhibit B. Applicant's Attorney believes that errors and/or omissions in the calculation and/or the PAIR system Patent Term Adjustment History may have resulted in an incorrect patent term adjustment for U.S. Patent No. 7,520,881 as described in detail below. Pursuant to 37 C.F.R. §1.705(d), this request for reconsideration is being filed within two months of the issue date of the above-referenced patent. Note that U.S. Patent No. 7,520,881 is not subject to a terminal disclaimer. In addition, there were no circumstances during the prosecution of the application resulting in the patent that constitute a failure of the Applicant to engage in reasonable efforts to conclude processing or examination of the present application as set forth in 37 C.F.R. §1.704.

**Period of adjustment pursuant to the PTO**

As detailed in the Patent Term Adjustment History that is attached as Exhibit B, the patent term adjustment indicated on the Notice of Allowance was 471 days.

**Period of adjustment pursuant to 37 C.F.R. § 1.703(a)(3)**

The period of adjustment pursuant to 37 C.F.R. § 1.703(a)(3) is the number of days in the period beginning on the day ("the 4 month date") after that date that is four months after the date a reply in compliance under 35 U.S.C. § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

A RCE was filed in response to a final rejection under 35 U.S.C. § 1.113(c) on **October 16, 2007**. A final office action was erroneously issued on October 30, 2007. During a telephone interview held with the Examiner, the Examiner acknowledged that the finality of the office action issued on October 30, 2007 was premature. The Examiner agreed to issue a new, non-final office action. Accordingly, the office action issued on October 30, 2007 was withdrawn and vacated, and a new non-final office action was mailed on **April 30, 2008**. The 4 month date specified in 37 C.F.R. § 1.703(a)(3) is **February 16, 2008**. The difference between the 4 month date and the date of mailing of the non-final Office Action is 74 days.

**Period of adjustment pursuant to 37 C.F.R. § 1.703(b)**

The period of adjustment pursuant to 37 C.F.R. § 1.703(b) is the number of days in the period beginning on the day ("the 3 year date") after the date that is three years after the date on which the application was filed pursuant to 35 U.S.C. § 111(a), not including the number of days in the period beginning with the filing of a RCE and ending with the issue date of the patent. Accordingly, the period of adjustment pursuant to 37 C.F.R. § 1.703(b) is the number of days in the period beginning on the "the 3 year date" and ending on the RCE filing date.

The present application was filed on **November 21, 2003** as evidenced by the official filing receipt attached as Exhibit C. The 3 year date determined pursuant to 37 C.F.R. § 1.703(b) is **November 21, 2006**. A first RCE was filed on **October 16, 2007**. The difference between the 3 year date and the filing of the first RCE is 329 days.

**Reduction in period of adjustment under 37 C.F.R. § 1.703(f)**

The period of adjustment under 37 C.F.R. § 1.703(f) is the sum of the periods calculated under 37 C.F.R. § 1.703(a) – (e), to the extent they are not overlapping.

The period of adjustment under 1.703(a)(3) is 74 days. The period of adjustment under 1.703(b) is 329 days. As the April 30, 2008 non-final Office Action was mailed after the “3 year date” of November 21, 2006, the overlap of these two periods is 0 days and hence additive. Accordingly, the total period of adjustment pursuant to 37 C.F.R. § 1.703 is 74 days + 329 days = 403 days.

**Total patent term adjustment**

Based on the foregoing, we believe that the correct patent term adjustment for U.S. Patent No. 7,520,881 should be the 471 days currently awarded by the PTO and an additional 403 days due to exceeding the 4 month date and the 3 year date for a total patent term adjustment of 874 days.

It is respectfully asserted that the patent term adjustment determined by the U.S. Patent and Trademark Office for U.S. Patent No. 7,520,881 may not be correct. Accordingly, Applicant’s Attorney respectfully requests the U.S. Patent and Trademark office to reconsider, and make revisions to the PAIR system Patent Term Adjustment History in view of the previous remarks to award 874 days. In addition, it is respectfully requested that the patent term adjustment be re-calculated by the U.S. Patent and Trademark Office in view of the above remarks. Moreover, it is respectfully requested a Certificate of Correction be issued for U.S. Patent No. 7,520,881 to indicate that 874 days of patent term adjustment have been awarded. Office personnel are invited to contact Applicant’s Attorney via telephone if such communication would be beneficial in fulfilling this request.

Applicants believe that the Office incorrectly did not honor the provisions of 35 U.S.C. § 154 by not counting the non-overlapping 74 day PTO delay and the non-overlapping 329 day PTO delay set forth above. Applicants are unaware of any statutory or legislative bases for the Office’s failure to consider these delays in the overall term adjustment. Applicants believe that

the Rules set forth by the PTO on this issue appear to be contrary to the specific language of this statute and the intended purpose set forth by Congress.

Applicants' position further finds support in a recent decision of the U.S. District Court for the District of Columbia (*Wyeth, et al. v. Jon W. Dudas*, Case 1:07-cv-01492-JR, September 30, 2008) to remand to the PTO for further proceedings that are consistent with the *Wyeth, et al. v. Jon W. Dudas* opinion, including the legislative history and intent underlying amendments to 35 U.S.C. § 154(b) by the Patent Term Guarantee Act of 1999 and the PTO's authority to prescribe regulations and procedures in accordance with 35 U.S.C. §§ 154(b)(2)(C)(iii) and 154(b)(3)(A)<sup>1</sup>. Like the plaintiffs in *Wyeth, et al. v. Jon W. Dudas*, Applicants similarly contend that the delays in the instant case constitute non-overlapping periods that should be included in the patent term adjustment in accordance with the statute and legislative history pertaining to 35 U.S.C. § 154.

Applicants reserve the right to appeal a denial of our petition in view of the remand of the *Wyeth, et al. v. Jon W. Dudas* case above.

---

<sup>1</sup> The PTO's current interpretation and implementation of patent term adjustments, including "double-counting" of non-overlapping periods of delay, such as under 35 U.S.C. § 154(b)(1)(A)(i)-(iv) and under 35 U.S.C. § 154(b)(1)(B) are set forth in 69 Fed. Reg. 34238 (2004). These policies have a direct bearing on the outcome of this petition.

Patent No. 7,520,881  
Serial No. 10/719,764

Date Issued: April, 21, 2009  
Date Filed: November 21, 2003

Respectfully submitted,

/Nilay Dalal/

Nilay Dalal

Registration No. 56,069

Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200